REMARKS

The undersigned notes with appreciation the designation of claims 4-7, 11, and 16-19 as being drawing to allowable subject matter.

Claims 1 - 21 remain active in this application. Claims 1, 8 and 12 have been amended to clarify the subject matter contained therein and improve descriptiveness. Support for these amendments can be found throughout the specification, particularly at pages 9-11. No new matter has been introduced into the application.

Claim 20 has been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,253,188 to Witek. Claims 1-2, 8-10, and 12-14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Witek. Claims 3 and 15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Witek in view of U.S. Patent 4,381,554 to Reach. Claim 21 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Witek in view of U.S. Patent 6,725,235 to Dyer. These rejections are respectfully traversed for the reasons of record and in view of the remarks below.

With regard to the rejection of claim 20 under 35 U.S.C. §102, MPEP 2131 expressly states that "to anticipate a claim, the reference must teach <u>every element</u> in the claim" (emphasis added). Further, MPEP 2131, citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1051, 1053 (Fed. Cir. 1987), states "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Witek describes a system for a computerized, interactive classified advertisement system and method for operating the system over the Internet (see abstract and col. 1, lines 5-21, in Witek), and fails to either teach or suggest a system designed to provide high specificity of search results, accommodate the addition of parameters and expansion of a range of options per parameter in the data without requiring conversion of existing configuration information. Witek does not address these latter problems to which a solution is provided by the invention and such specificity and the identification is not even appropriate to the environment of Witek where "browsing" is desirable (see columns 13-16, and Figure 3, in Witek as relied on by the Examiner). It is, therefore, respectfully submitted that the Examiner has failed to establish his *prima facie* burden under 35 U.S.C. §102.

More specifically and in contrast to the invention as claimed, Witek teaches using category and subcategory identification 48, 50 to locate a *range* of records and individual records which have arbitrary, multi-character separate record value fields for primary and secondary selection parameters 60, 62 which are presented in separate fields to further refine selection among the *range* of records returned and which are independent of and not reflected in the record identifications 58.

In addition to the arguments presented in the Applicant's response of March 21, 2005, Witek clearly fails to teach or suggest every element recited in claim 20. Particularly, the Examiner has asserted that Witek teaches "one of the options for each parameter corresponding to the configuration" (see pages 2-3 of the Office Action). However, the passage relied on by the Examiner (column 16, lines 5-20) clearly suggests otherwise. Assuming *arguendo* that the "associated field number" equates to "one of the options", and the "ad record" equates the "multiparameter configuration", in claim 20, Witek would still not anticipate the subject matter because Witek clearly states that "to maintain compactness, the identification number *is not included in the ad record itself*" (see column 16, lines 11-12, in Witek. emphasis added). Conversely, in accordance with the invention, as shown in Figure 2, because each of the options are expressed in the respective parameters, and each of the parameters are part of the multiparameter configurations in claim 20, "one of the options for each parameter" *is included* in the multiparameter configuration and the identifier, contrary to the teachings of Witek which provides for location of ads having a classification and some selectivity as a further step based on primary and secondary selection parameters, allowing user interaction similar to the browsing of a hard copy of classified ads. Therefore, the rejection of claim 20 is respectfully traversed as being in error, failing to support a *prima facie* demonstration of anticipation under 35 U.S.C. §102, as Witek fails to teach or anticipate the explicitly recited novel aspects of the present invention because the identification number is not included in the ad record (see column 16, lines 11-12, in Witek) and, in any event, does not specifically identify a combination of options for respective parameters representing a specific configuration.

With regard to all of the rejections made under 35 U.S.C. §103, MPEP 2144 states that "obviousness cannot be established by combining references 'without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done'", *quoting, Ex parte Levengood*, 28 USPQ2d 1300, 1302 (1993). Moreover, MPEP 2141.01(a), citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), explicitly states that "in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." Furthermore, MPEP 2143.01 explicitly states that "obviousness can only be established by combining or modifying the teachings of the prior art *to produce the claimed invention* where there is some *teaching, suggestion, or motivation to do so* found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." (emphasis added). In other words, the combination of references and/or the level of ordinary skill in the art must address *every recited feature of the claims* while including a showing of motivation for each point of combination or modification proposed in support of the rejection. The Examiner has failed to establish his *prima facie* burden of demonstrating obviousness under 35 U.S.C. §103 by neglecting to cite to a teaching, suggestion, or motivation in Witek, Reach and/or Dyer that, when combined, would make the claimed invention obvious to one of ordinary skill in the art.

Although the Examiner has rejected claims 1-2, 8-10, and 12-14 as being unpatentable over Witek, the Examiner has admitted Witek fails to teach "constructing the identifier based on the value of each option corresponding to the configuration" (see pages 4-5 in the Office Action) which is an important feature supporting the meritorious and unexpected function of the claimed invention. Further, the Examiner cites Witek rationalizing that since "Witek constructs the associated field number associated with [the] parameter", constructing an identifier based on the value of each option would be made obvious to one skilled in the art. *Id.* However, it is respectfully submitted that the Examiner's assertion fails to demonstrate a teaching, suggestion or motivation for one skilled in the art to construct an <u>identifier</u> based on the value of each option

and where an increased number of options can be accommodated without change of existing data. Witek does not address the problems solved by the claimed invention, as previously discussed, and constructing an identifier in accordance with the claimed invention is not even appropriate to the environment of Witek where "browsing" (e.g. of less specific search results) is desirable (see columns 13-16, and Figure 3, in Witek). Moreover, the Examiner's assertions regarding "field number" necessarily imply reliance on Witek on use of multiple fields to express information in the records whereas the invention explicitly recites representing such information in a single identifier (of a record) which not only supports high specificity of search results through a simplified and expedited search beyond that to which Witek is directed but the ability to increase the number of parameters or options per parameter without alteration of existing data. From this viewpoint, in particular, Witek seems to teach away from the invention and the Examiner's assertion is seen to be indicative of impermissible hindsight. Particularly, Witek uses a multi-digit numerical value to represent each of a plurality of distinct menu texts and provide each parameter as a separate field in record selection tables. Records are identified by consecutive numbers or number and offset unrelated to parameters in order to return a range of records of possible interests which can be browsed, whereas the parameters of interest in accordance with the present invention are respective digits of a single numerical/symbolic field such that each identifier corresponds to a particular distinct (but not necessarily unique) configuration with high specificity.

Even more specifically, with reference to Figure 3 and column 11, line 40 - column 17, line 62 of Witek, it can be seen that the ad searching structure is comprised of a category/subcategory hierarchal searching system and method admitted to be "well known in the art." Particularly, Witek teaches the use of a binary technique to search the classified ad database (see columns 13-14 in Witek). Binary techniques are generally designed to work irrespective of the number of fields per record and fail to leverage characteristics of records that may facilitate search and increase specificity of search results. In this regard, Witek acknowledges that when the number of categories and/or subcategories increase, the ease of use decreases (see column 13, lines 10-13, in Witek). Conversely, the ease of use does not vary in the present invention when

the number of parameters and options per parameter increases due to the use of *an identifier contained in a single field*. In fact, the method and system disclosed in the present invention is specifically designed to accommodate the addition of parameters and expansion of a range of options per parameter without requiring conversion of existing configuration information. This meritorious effect is supported by identifying a configuration using an identifier having a plurality of digits, said configuration having a plurality of parameters and each of said parameters having a plurality of options (see claim 1), which is not taught or suggested by Witek. Therefore, the rejection of claims 1-2, 8-10, and 12-14 is respectfully traversed as being in error, lacking a *prima facie* demonstration of obviousness under 35 U.S.C. §103 and thus untenable, as Witek fails to provide teachings or suggestions or evidence of a level of ordinary skill in the art which could support a conclusion of obviousness of the present invention, as claimed. Witek does not lead to an expectation of success in achieving the meritorious effects of the invention, much less by constructing an identifier in the manner claimed.

The Examiner has rejected claims 3 and 15 as being unpatentable over Witek in view of Reach. In his rejection, the Examiner asserts that Witek teaches all of the elements of claims 3 and 15, except "the step of assigning an exponent to each digit of the identifier and the exponent being equal to the digit place minus one" (see pages 6-7 of the Office Action) and cites to Reach as teaching this deficiency. However, it is respectfully submitted that Reach is neither in the present invention's field of endeavor, nor reasonably pertinent to the problem solved by the present invention (see MPEP 2141.01(a)).

Particularly, Reach describes a calculator that automatically evaluates numerical answers while using minimal storage capacity and avoiding the application of complex stored programs (see abstract and columns 1-2 in Reach). While Reach may teach the "identification of the proper positive or negative exponent of [a] radix multiplier identified", it does not teach an identification with respect to assigning an exponent to each digit of an identifier. Specifically, Reach teaches this identification method with respect to conversion of digital numbers into an "easy-to-read form suitable for printing with decimal points properly indicated" (see column 2, lines 53-56, in Reach). The Reach identification method is not used in connection with the

facilitation of storage, searching and retrieval of computerized information. Therefore, it would not be obvious to one skilled in the art to combine the Reach identification method with the binary search technique in Witek. Moreover, the identifier of Reach is not compatible with processing by Witek and the proposed modification of Witek would be improper under *In re Gordon*, 221 U.S.P.Q. 1125 (1984), since operation in the intended manner would be precluded because, as previously discussed, the Witek system is not designed to accommodate the addition of parameters and expansion of a range of options per parameter without requiring conversion of existing configuration information.

Lastly, the Examiner has rejected claim 21 as being unpatentable over Witek in view of Dyer. In his rejection, the Examiner asserts that Witek teaches all of the elements of claim 21, except "the step of the multi-parameter configuration identified by the identifier includes an illegal configuration reference if the multi-parameter configuration is not valid for the subject matter" (see paragraph 21of the Office Action) and cites Dyer as teaching this deficiency. However, it is respectfully submitted that it would not be obvious to one skilled in the art to combine Witek and Dyer without employing impermissible hindsight (see MPEP 2142: "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art").

Particularly, Dyer teaches a method for using a computer system to dynamically represent the state of any device that is comprised of a multitude of sub-systems (see abstract of Dyer). While Dyer may teach the altering of an appearance within a hierarchial model when an integer is an invalid value, it does not teach the <u>inclusion</u> of an illegal configuration if a multi-parameter configuration is not valid based on the subject matter. Specifically, Dyer teaches this alteration method with respect to the "invalid value" of an integer symbol by <u>visually</u> changing its appearance (*e.g.*, color, bold, flashing, etc., to change its appearance) (see columns 4-5, and Figure 5, in Dyer). The Dyer alteration method is not used in connection with the facilitation of storage, searching and retrieval of computerized information. Therefore, it would not be obvious to one of ordinary skill in the art to combine the Dyer alteration method with the binary search technique in Witek.
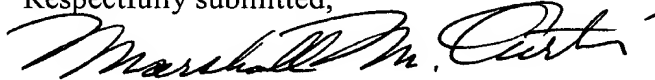
Accordingly, it is respectfully submitted that none of the references cited by the Examiner, either alone or in combination, teach nor suggest the system and method contemplated by the present invention and the rejection of claims 1-21 is clearly in error and untenable. Witek fails to directly answer the recitations of the claims and does not, taken alone or in combination with other prior art of record, support modification to answer the claim recitations consistent with operation of the respective references in the intended manner or supply evidence of a level of ordinary skill in the art which could support a conclusion of obviousness or any claim or otherwise support a *prima facie* demonstration of anticipation or obviousness thereof. Therefore, reconsideration and withdrawal of the rejections under 35 U.S.C. §102 and §103 of claims 1 – 21, and the allowance of the application are respectfully requested.

It is also respectfully submitted that the finality of the present office action is premature and should be withdrawn to allow the above-requested amendments to be made as a matter of right. It is axiomatic that an action should not and cannot properly be made final when it does not contain a *prima facie* demonstration of the propriety of grounds of rejection contained therein. In any event, it is respectfully submitted that the requested amendments are limited to revision of language to improve descriptiveness consonant with the scope of other claims for which no amendment has been requested (e.g. claim 20) while the claims remain directed to the combinations of features recited in the claims as finally rejected. Therefore, logically, the above-requested amendments do not and cannot raise new issues while, in fact, reducing and simplifying issues and improving form to place the application in condition for allowance or, in the alternative, better form for appeal. Therefore entry of the above-requested amendments is believed to be well-justified and in order.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 50-2041.

Respectfully submitted,

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